

Remarks

Reconsideration of this Application is respectfully requested. The proposed amendments are made solely to advance prosecution of the claims. The amendments do not add claims without canceling an equal number of pending claims, do not require further searching, do not create new issues and place the application in condition for allowance or better form for appeal.

Upon entry of the foregoing amendments, claims 1-4 and 6-14 are pending in the application, with claim 1 being the independent claim. Claims 9-14 were previously withdrawn pursuant to the Restriction Requirement of October 15, 2007 which necessitated a selection between conjugated claims and method claims. Claims 9 and 10 have been amended to recite a "conjugate" rather than a "method." Thus, Applicants contend that claims 9 and 10 would fall within the selection of Group I as specified in the Reply to Restriction Requirement filed November 15, 2007. Thus, consideration of claims 9 and 10 is respectfully requested, and their status has been revised from "withdrawn" to "currently amended." Claim 5 was previously cancelled. Claim 1 has also been amended. Support for the amendment to claim 1 can be found throughout the application as filed, e.g., in originally filed claim 5. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Miscellaneous Matter

Applicants thank the Examiner for reconsideration and removal of the rejection of claim 1-7 under 35 U.S.C. § 102(a).

Rejections under 35 U.S.C. § 102

Claims 1, 3, 4 and 6 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Cook et al. (U.S. Pat. No. 5,717,083, "Cook") as evidenced by Agrawal et al. (*PNAS* 85:7079-7083 (1988)) and www.newton.dep.anl.gov. Applicants respectfully traverse this rejection.

Specifically, the Examiner alleged that Cook teaches oligomeric compounds comprising phosphoroamidate-linked PEG. Solely to advance prosecution, claim 1 has been amended to delete the term "phosphoroamidate linkage." Thus, the claimed invention is not anticipated by Cook. The Examiner is respectfully requested to reconsider and withdraw the outstanding rejections under 35 U.S.C. §102(b).

Rejections under 35 U.S.C. § 103

Claims 1, 3, 4 and 6 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Tullis (U.S. Pat. No. 4,904,582) and Goodchild (*Bioconj. Chem.* 1:167-187 (1990)). Applicants respectfully traverse this rejection.

Specifically, the Examiner alleged that Tullis describes oligonucleotide conjugates for transport across cellular membranes. The Examiner acknowledges that Tullis does not teach an oligonucleotide covalently linked to PEG via a phosphoramidate linkage or an acetal bond. However, the Examiner alleged that Goodchild teaches that

conjugate groups can be covalently linked to oligonucleotides by phosphoramidate linkage. Solely to advance prosecution, claim 1 has been amended to delete the term "phosphoroamidate linkage" and to recite an acetal linkage. Neither Tullis, Goodchild or any combination of both teach an oligonucleotide covalently linked to the hydrophilic polymer via an acid cleavable linkage, which is an acetal. Thus, each and every element of the claim has not been taught and a prima facie case of obviousness has not been established. Moreover, the cited documents provide no rationale or apparent reason for making the claimed invention. In light of the above, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections under 35 U.S.C. §103.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Amdt. dated April 9, 2010 - 7 -
Reply to Office Action of November 9, 2009

JEONG *et al.*
Appl. No. 10/551,466

Prompt and favorable consideration of this Amendment and Reply is respectfully
requested.

Respectfully submitted,

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